



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/774,828

07/06/2004

Jonathan Martinek

2821

9771

50855

7590

09/19/2008

Tyco Healthcare Group LP
60 MIDDLETOWN AVENUE
NORTH HAVEN, CT 06473

EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

09/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/774,828	Applicant(s) MARTINEK ET AL.	
	Examiner JAMES L. SWIGER III	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,10,11 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,10,11 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/4/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/11/2008 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Giesy et al. (US Patent 5,152,749). Giesey et al. ("Giesy") discloses an instrument kit comprising a first template with a substantially linear body (22) and a proximal end (22a), a second template (20) with a second proximal end (20a) with a distal end curving in a first arc (20c), and a third template with a third elongate body (22) with a third proximal end (near 14), curving in a second direction with a second arc (depending on how one looks at the device, and wherein the arc is more curved (32) and different than the first arc (20c), and a handle (12) which is configured and dimensioned for selective engagement and are interchangeably deployable with the proximal ends of

Art Unit: 3733

the templates (see Fig. 1). The templates also include various attachment structures (22a/20a). Also while the arcs are substantially equivalent, the second arc is greater than the first arc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim is 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Giesy in view of Scribner et al. (US Patent 7,153,307). Giesy discloses the claimed invention except for specifically the handle and template interface is a snap-fit arrangement. Scribner et al. disclose a snap fit arrangement between the handle and template (see Fig. 3, 68/70) that allows for a quick, yet positive connection and further allowing the templates to be switched as needed but still be secured with the handle. See also Col. 7, lines 40-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Giesy having at least a handle/template snap-fit arrangement in view of Scribner to better use the device during surgery for quick release and interchangeability.

Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giesy et al. (US Patent 5,152,749). Giesy discloses the claimed invention except for specific arc ranges. With It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the templates having ranges from 3-15 degrees and 15-45 degrees, respectively, since it has been held that where the

Art Unit: 3733

general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 1, 4-6, 21-23, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benderev et al. (US Patent 5,439,467) in view of Schreiber (US Patent 4,635,637) and Riza (US Patent 3,842,824) and Scribner et al. (US Patent 7,153,307).

Benderev et al. disclose an instrument kit capable of performing a repair procedure having at least one template (see Fig. 1) that has an elongated body that defines an X, Y and Z axis. The elongated body would be sufficient to access a meniscal repair, and likewise has a slim, reduced profile for use. Likewise, after removal, a correspondingly-dimensioned meniscal repair device could be introduced along that same path created by the templating device. Benderev et al. also disclose what may be considered an atraumatic tip (140/120) designed to produce minimal injury to tissue, and an elongate body that has an end portion that is obliquely, or offset at an angle, arranged with respect to an x-axis (see bent end in Fig. 1a). Note that the device is capable of being offset in a z-axis, depending on how one looks at it. Benderev et al. also disclose at least two templates (compares figs. 1 and 1a), each body defining X, Y, and Z axes. The elongate body of the first template (Fig. 1) is substantially linear, while the end portion of the second template is considered obliquely arranged (Fig. 1a), and may be considered offset in a Y-axis.

Benderev et al. disclose the claimed invention except for more specifically (or alternatively) a height along a Z-axis and a width along the Y-axis, and the width

Art Unit: 3733

substantially less than the height, and also a dimple portion configured and adapted to engage a fastener. Depending on where the axes are labeled, Schreiber discloses a template instrument that initially in Fig. 4 has a “wide” appearance, but extruded to the 3-D figure would have an X-Y-Z axis, and wherein the width would be greater than the height. This structure is designed to optimally fit within a meniscal tear (See Col. 2, lines 42-45). Schreiber also discloses a dimple portion (56/56) that that delivers a fastener (the suture anchor), to aid in delivery of the fastener (Col. 3, lines 10-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Benderev et al. having at least the required axes and dimple of Schreiber to better use and access the tear in a surgical application.

The combination of Benderev et al. and Schreiber disclose the claimed invention except for structures in the handle for attachment to the template portion including a bore, groove, lock rod, and configured depths. Riza disclose a portion that is considered a lock rod (53) that is considered connected to, and part of the template. This extends transversely to the longitudinal axis. Additionally Riza discloses that the handle has a bore and groove (see 44 and Fig. 7) with two dimensions extending obliquely (see Fig. 7) that further define two depths, or height, depending on how one views the device or it is configured (see also Fig. 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the instrument kit of the combination of Benderev et al. (US Patent 5,439,467) in view of Schreiber (US Patent 4,635,637) having at least the connection bore and rod of Riza for the purpose of having a more secured connection between the handle and template and still allowing for a

Art Unit: 3733

removable connection. It is noted that the locking rod portion of Riza connects the templated from portion at the proximal portion of a handle instead of a distal end.

Though the template/handle could still be interchanged, having the junction at the other end of the handle would have been an obvious modification of rearrangement of parts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the template/handle connection since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Benderev et al. and Schreiber and Riza disclose the claimed invention except for where the template handle is connectable in a snap-fit arrangement. Scribner et al. disclose a snap fit arrangement between the handle and template (see Fig. 3, 68/70) that allows for a quick, yet positive connection and further allowing the templates to be switched as needed but still be secured with the handle. See also Col. 7, lines 40-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Benderev and Schreiber and Riza having at least a handle/template snap-fit arrangement in view of Scribner to better use the device during surgery for quick release and interchangeability.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benderev et al. (US Patent 5,439,467) in view of Schreiber (US Patent 4,635,637) and Riza (US Patent 3,842,824) and Scribner et al. (US Patent 7,153,307) disclose the claimed invention except for a kit bore and locking groove having a rectangular shape. It would have been an obvious matter of design choice to one skilled in the art at the time

Art Unit: 3733

the invention was made to construct the bore having a rectangular shape, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a forming edge in the heating portion or clamp. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benderev et al. (US Patent 5,439,467) in view of Schreiber (US Patent 4,635,637) and Riza (US Patent 3,842,824) and Scribner et al. (US Patent 7,153,307) as applied to claim 1 above, and further in view of Barreiro et al. (US Publication 2002/0002374). The combination discloses the claimed invention except for disposable loading units. Berreiro disclose an apparatus with a handle area and a template that also has disposable loading units (see 13, fig. 2, and abstract). The disposable loading units assist in repairing the meniscal tear. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination having at least the disposable loading units for assistance in meniscal repair.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-6, 10-11, 21-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733

Application/Control Number: 10/774,828
Art Unit: 3733

Page 9